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HEWLETT-PACKARD COMPANY
Intellectual Property Administration
P.O. Box 272400
Fort Collins, Colorado 80527-2400

PATENT APPLICATION

ATTORNEY DOCKET NO. ___10017722-1___

Inventor(s):   Christopher A Mesa et al.

Application No.: 09/944,659

Filing Date: Aug. 31, 2001

Confirmation No.: 1784

Examiner: T. Chuong

Group Art Unit: 2174

Title: Scanning To At Least One Of Multiple Destinations

Mail Stop
Commissioner For Patents
PO Box 1450
Alexandria, VA 22313-1450

TRANSMITTAL LETTER FOR RESPONSE/AMENDMENT

Transmitted herewith is/are the following in the above-identified application:

- ☐ Response/Amendment
- ☐ New fee as calculated below
- ☒ No additional fee
- ☒ Other   Opening Brief On Appeal (Amended)

- ☐ Petition to extend time to respond
- ☐ Supplemental Declaration

Fee$ 0

		CLAIMS AS AMENDED BY OTHER THAN A SMALL ENTITY				
(1) FOR	(2) CLAIMS REMAINING AFTER AMENDMENT	(3) NUMBER EXTRA	(4) HIGHEST NUMBER PREVIOUSLY PAID FOR	(5) PRESENT EXTRA	(6) RATE	(7) ADDITIONAL FEES
TOTAL CLAIMS		MINUS		= 0	X $50	$ 0
INDEP. CLAIMS		MINUS		= 0	X $200	$ 0
☐ FIRST PRESENTATION OF A MULTIPLE DEPENDENT CLAIM					+ $360	$ 0
EXTENSION FEE	☐ 1st Month $120	☐ 2nd Month $450	☐ 3rdMonth $1020	☐ 4th Month $1590		$ 0
					OTHER FEES	$ 0
				TOTAL ADDITIONAL FEE FOR THIS AMENDMENT		$ 0

Charge $___0___ to Deposit Account 08-2025. At any time during the pendency of this application, please charge any fees required or credit any over payment to Deposit Account 08-2025 pursuant to 37 CFR 1.25. Additionally charge any fees to Deposit Account 08-2025 under 37 CFR 1.16 through 1.21 inclusive, and any other sections in Title 37 of the Code of Federal Regulations that may regulate fees. A duplicate copy of this sheet is enclosed.

I hereby certify that this paper is being transmitted to the Patent and Trademark Office facsimile number (571) 273-8300.
Date of facsimile: September 22, 2006

Typed Name: Joanna Key

Signature:

Respectfully submitted,

Christopher A Mesa et al.

By

Steven R. Ormiston

Attorney/Agent for Applicant(s)

Reg No. :   35,974

Date :   September 22, 2006

Telephone :   (208) 433-1991

Rev 10/05 (TransAmdFax)

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IN THE
UNITED STATES PATENT AND TRADEMARK OFFICE

INVENTOR(S): Chris Mesa et al.

ATTORNEY DOCKET NO: 10017722-1

SERIAL NO.: 09/944,659

GROUP ART UNIT: 2174

FILED: August 31, 2001

EXAMINER: T. Chuong

TITLE: Scanning To At Least One Of Multiple Destinations

APPELLANTS'/APPLICANTS' OPENING BRIEF ON APPEAL (AMENDED)

This amended appeal brief is submitted in response to the Notification of Non-
Compliant Appeal Brief mailed August 23, 2006. Section 5, Summary Of Claimed
Subject Matter, has been amended. No other changes were made to the Brief as
originally filed (except for these introductory paragraphs). While the Applicants have
made a good faith effort to meet the concerns noted by the Examiner in the Notification,
the Examiner's remarks are not consistent with Rule 41.37(c)(1)(5), which requires a
"concise explanation of the subject matter defined in each of the independent claims
...." The rule does not require a concise explanation of the subject matter defined in
"*each limitation*" in each independent claim, as required by the Examiner. Applicants
have provided both a concise explanation of the determinative subject matter of the
independent claims along with a listing of the claim elements in an effort to concisely
explain the subject matter and to provide supporting citations to every claim element.

1.   REAL PARTY IN INTEREST.

The real party in interest is Hewlett-Packard Development Company, LP, a
limited partnership established under the laws of the State of Texas and having a
principal place of business at 20555 S.H. 249 Houston, TX 77070, U.S.A. (hereinafter
"HPDC"). HPDC is a Texas limited partnership and is a wholly-owned affiliate of

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Hewlett-Packard Company, a Delaware Corporation, headquartered in Palo Alto, CA.
The general or managing partner of HPDC is HPQ Holding, LLC.

2.   RELATED APPEALS AND INTERFERENCES.

There are no other appeals or interferences known to Appellants, Appellants'
legal representative or the Assignee which will affect or be directly affected by or have a
bearing on the Board's decision in the pending appeal.

3.   STATUS OF CLAIMS.

Claims 23-31 are pending. The rejections of all of the pending claims are
appealed.

4.   STATUS OF AMENDMENTS.

All amendments have been entered. No amendments were filed after the final
action.

5.   SUMMARY OF CLAIMED SUBJECT MATTER.

The following "concise explanation" of the subject matter recited in each of the
independent claims is provided solely because it is required as a "summary" by 37
C.F.R. § 41.37(c)(1)(5). This explanation/summary is not intended to nor does it define
the claimed subject matter and, therefore, it should not be used to interpret the claims
or to limit or narrow the scope of the claims.

Concisely explained, Claims 23 and 28 are directed to a method and computer
instructions, respectively, through which an input peripheral scans a document in
response to the destination device requesting that the input peripheral begin
transmitting data.

Concisely explained, Claims 27 and 31 are directed to a method and computer
instructions, respectively, through which an input peripheral scans a document in
response to the destination device acknowledging a notification from the input
peripheral. In addition, these claims involve a two-tiered destination selection scheme -
- displaying a user interface from which multiple destination devices and a resource on

the destination device(s) may be selected to receive data from the input peripheral.

Claim 23 recites a scanning method that includes:

displaying a user interface from which one or more of multiple destination devices may be selected to receive data from an input peripheral having a scanning capability (Fig. 1, display 114; Fig. 2, step 210; and Specification, page 9, lines 21-23 and page 11, lines 8-10);

the input peripheral notifying a selected destination device that the device has been selected to receive data (Fig. 2, step 214 and Specification, page 11, lines 12-13);

in response to the notifying, the selected destination device requesting that the input peripheral begin transmitting data to the selected destination device (Fig. 3, step 316 and Specification, page 12,lines 2-3); and

in response to the requesting, the input peripheral scanning a document and transmitting data representing the document to the selected destination device (Fig. 2, steps 216, 218 and 220 and Specification, page 11, lines 17-20).

Claim 27 recites a scanning method that includes:

displaying a user interface from which one or more of multiple destination devices may be selected to receive data from an input peripheral having a scanning capability and from which a resource on one or more of the multiple destination devices may be selected to receive data from the input peripheral (Fig. 2, step 210 and Specification, page 10, lines 8-21 and page 11, lines 8-10);

the input peripheral notifying a selected destination device that the device and a resource on the device have been selected to receive data (Fig. 2, step 214 and Specification, page 11, lines 12-13);

in response to the notifying, the selected destination device acknowledging a notification from the input peripheral (Fig. 3, step 316 and Specification, page 12,lines 2-3); and

in response to an acknowledgement from the selected destination device, the input peripheral scanning a document and transmitting data representing the document to a resource on the selected destination device selected to receive data from the input peripheral (Fig. 2, steps 216, 218 and 220; Fig. 3, steps 318 and 320; and Specification, page 11, lines 17-20 and page 12, lines 4-5).

Claims 28 and 31 are computer medium counterparts to method Claims 23 and 27, respectively, and recite similar limitations. Hence, the supporting citations to the Specification are the same.

6.   GROUNDS FOR REJECTION TO BE REVIEWED.

A.   Leclair 2003/0055866 does not teach an input peripheral scanning a document and transmitting data representing the document to the selected destination device in response to the destination device requesting that the input peripheral begin transmitting data (Claims 23 and 28) or in response to the destination device acknowledging a notification from the input peripheral (Claims 27 and 31). Ground A applies to the Sections 102 and 103 rejections of all pending claims.

B.   Leclair does not teach a two tiered destination selection scheme as claimed. Ground B applies to the Sections 102 and 103 of Claims 25-27 and 30-31.

7.   ARGUMENT.

A.   Ground For Rejection A (Claims 23-31) – Leclair Does Not Teach an input peripheral scanning a document and transmitting data representing the document to the selected destination device in response to the destination device requesting that the input peripheral begin transmitting data or in response to the destination device acknowledging a notification from the input peripheral.

Claims 23-25 and 27-31 have been rejected under Section 102 as being anticipated by Leclair 2003/0055866. Claim 26 was rejected under Section 103 as being obvious over Leclair in view of Neuman 6744761. The rejections are all based on the assertion that Leclair teaches an input peripheral scanning a document and transmitting data representing the document to the selected destination device in response to the destination device requesting that the input peripheral begin transmitting data or in response to the destination device acknowledging a notification from the input peripheral. Applicants respectfully submit that this assertion is not correct.

Claim 23 recites the input peripheral scanning a document and transmitting data representing the document to the selected destination device in response to the destination device requesting that the input peripheral begin transmitting data. Claim

27 recites the input peripheral scanning a document and transmitting data representing the document to a resource on the selected destination device in response to the destination device acknowledging a notification from the input peripheral. Claims 28 and 31, as computer medium counterparts to Claims 23 and 27, contain similar limitations.

In Leclair, input device 650 has already scanned the document and converted the images to digital data before receiving any communication from destination device 600. Leclair paragraph [0038]. Leclair does not teach or even suggest the scanner scanning the document in response to a request or acknowledgement from the destination device as claimed. Leclair, therefore, does not teach or suggest all of the limitations of Claims 23, 27, 28 and 31 and their respective dependent claims as required to support the Section 102 rejections (and the Section 103 rejection of Claim 26).

In reply, the Examiner states at page 6 of the final Action:

"Leclair clearly teaches that the input peripheral input devices such as the scanner, copy machine, camera, and fax machine, etc. start scanning/capturing the documents/images with initiation of transmission at the input device by putting the document on the scanner, or turning on the camera ([0038]); then the input device will convert the image to digital image for transmitting via the Network." (emphasis in original)

Conspicuously absent from the Examiner remarks is any reference to a passage in Leclair teaching that the acts of "scanning/capturing" are performed in response to the destination device requesting that the input peripheral begin transmitting data or in response to the destination device acknowledging a notification from the input peripheral. Absent such a showing, the Examiner has failed even to establish a prima facie case of anticipation.

B.   Ground For Rejection B (Claims 25-27 and 30-31) – Leclair Does Not Teach A Two Tiered Destination Selection Scheme As Claimed.

Claims 25 and 27 recite a two tiered destination selection scheme – (1) displaying a user interface from which one or more of multiple destination devices and a resource on one or more of the devices may be selected to receive data from an input peripheral and (2) the input peripheral transmitting data representing the document to

the resource on the selected destination device(s). Claims 30 and 31, as computer medium counterparts to method Claims 25 and 27, contain similar limitations.

Leclair suggests only the selection of a destination device, not a resource on the destination device. In support of the rejection of Claims 25 and 27, the Examiner states "[f]rom the input device/scanner/fax, the user can input various network addresses, a fax number (a resource) of the selected destination to transmit data, e.g., [0038]-[0039], and [0042], [0053]) may be selected...." Final Action page 4. This statement is not accurate. There is nothing in Leclair that even remotely suggests a fax number is a resource on a destination device, as opposed to the destination device itself. With regard to a fax machine, Leclair teaches only that when the input device 650 is "a fax machine that accepts a document" the user is allowed to input "various network addresses that would like to receive the faxed information." Leclair paragraph [0038]. There is not the least suggestion at all in Leclair that the user is also allowed to input a fax number or any other resource at the network address/destination device.

Leclair, therefore, does not teach or suggest all of the limitations of Claims 25, 27 and 31 and Claim 26 depending from Claim 25 as required to support the Section 102 rejections (and the Section 103 rejection of Claim 26).

In reply, the Examiner states at page 6 of the final Action:

"Leclair clearly provides in [0038] that the input device 650 can be a fax machine, which allows the user to input various Network Addresses or a list of addresses that would like to receive the faxed information; therefore, the fax machine of Leclair contains the list of destination addresses or fax numbers considered as well known or inherence [sic] in the art without any further explanation."

The Examiner's remarks fail to address that the claims require that the fax number (or other resource) be a resource on the destination device, not the destination device itself. An example from the Specification may help illustrate the distinction:

" The display may, for example, show more specific listings such as:

Anne's PC:Email

Anne's PC:AppName

Bill's PC:Fax

Bill's PC:FileName

Fred's NT Machine:AppName

In these examples, the text prior the colon (":") indicates the primary target (i.e., the host). The text following the colon indicates the secondary target (e.g., the name of the application to receive the data, the name of the file to store the data, etc.). Alternatively, the options may be displayed in the step-through type hierarchy. In such a scenario, after the user selects a primary target, a list of 20 secondary targets associated with that primary target is displayed. The user may select the secondary target from that list." Specification, page 10 lines 8-21.

In this example, the user interface display allows the user to select the destination device (e.g., Anne's PC) and a resource on the destination device (the email or an application on Anne's PC). Leclair does not teach or suggest any such two-tiered destination selection scheme and there is nothing to the contrary in the passages cited in the Examiner's remarks. The Examiner has, therefore, failed even to establish a prima facie case of anticipation.

Respectfully submitted,

/Steven R. Ormiston/

Steven R. Ormiston
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(208) 433-1991 x204

APPENDIX OF CLAIMS INVOLVED IN THE APPEAL

23.   A scanning method, comprising:

displaying a user interface from which one or more of multiple destination devices may be selected to receive data from an input peripheral having a scanning capability;

the input peripheral notifying a selected destination device that the device has been selected to receive data;

in response to the notifying, the selected destination device requesting that the input peripheral begin transmitting data to the selected destination device; and

in response to the requesting, the input peripheral scanning a document and transmitting data representing the document to the selected destination device.

24.   The method of Claim 23, wherein the input peripheral comprises a scanner or a multifunction peripheral.

25.   The method of Claim 23, further comprising displaying a user interface from which a resource on one or more of the multiple destination devices may be selected to receive data from the input peripheral and wherein the input peripheral scanning a document and transmitting data representing the document to the selected destination device comprises the input peripheral scanning the document and transmitting data representing the document to a resource on the selected destination device selected to receive data from the input peripheral.

26.   The method of Claim 25, wherein the resource comprises an application program, a telephone number for a facsimile transmission of the data, an email address to send the data, or a storage location to store the data.

27.   A scanning method, comprising:

displaying a user interface from which one or more of multiple destination devices may be selected to receive data from an input peripheral having a scanning capability and from which a resource on one or more of the multiple destination devices may be selected to receive data from the input peripheral;

the input peripheral notifying a selected destination device that the device and a resource on the device have been selected to receive data;

in response to the notifying, the selected destination device acknowledging a notification from the input peripheral; and

in response to an acknowledgement from the selected destination device, the input peripheral scanning a document and transmitting data representing the document to a resource on the selected destination device selected to receive data from the input peripheral.

28.   A computer readable medium having computer executable instructions thereon for:

displaying a user interface from which one or more of multiple destination devices may be selected to receive data from an input peripheral having a scanning capability;

the input peripheral notifying a selected destination device that the device has been selected to receive data;

in response to the notifying, the selected destination device requesting that the input peripheral begin transmitting data to the selected destination device;

in response to the requesting, the input peripheral scanning a document and transmitting data representing the document to the selected destination device.

29.   The medium of Claim 28, wherein the input peripheral comprises a scanner or a multifunction peripheral.

30.   The medium of Claim 28, further comprising instructions for displaying a user interface from which a resource on one or more of the multiple destination devices may be selected to receive data from the input peripheral and wherein the instructions for the input peripheral scanning a document and transmitting data representing the document to the selected destination device comprise instructions for the input peripheral scanning the document and transmitting data representing the document to a resource on the selected destination device selected to receive data from the input peripheral.

31.   A computer readable medium having computer executable instructions thereon for:

displaying a user interface from which one or more of multiple destination devices may be selected to receive data from an input peripheral having a scanning capability and from which a resource on one or more of the multiple destination devices may be selected to receive data from the input peripheral;

the input peripheral notifying a selected destination device that the device and a resource on the device have been selected to receive data;

in response to the notifying, the selected destination device acknowledging a notification from the input peripheral; and

in response to an acknowledgement from the selected destination device, the input peripheral scanning a document and transmitting data representing the document to a resource on the selected destination device selected to receive data from the input peripheral.

APPENDIX II -- EVIDENCE SUBMITTED UNDER RULES 130, 131 OR 132

APPENDIX III – RELATED PROCEEDINGS